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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,253	06/16/2006	Changmoon Han	126587-0028	1173
23429 7590 09/03/2008 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER ZEWARI, SAYED T				
ART UNIT 2617		PAPER NUMBER		
MAIL DATE 09/03/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/541,253

Applicant(s)

HAN ET AL.

Examiner

SAYED T. ZEWAR

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-7, and 9-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-25 of copending Application No. 10541251 in view of Kolev et al. (US 6, 125,283).

This is a provisional obviousness-type double patenting rejection.

Claims 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 8, 12, 15, 21, and 11 of U.S. Application

No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly *updating an overhead message and notifying 1xEV-DO system of switching from 1xEV-DO mode to 1X mode*. That is, the applicant claims that the hybrid terminal periodically switches into the 1X mode in order to update an overhead message. The conflicting claim1 also disclose the same function. That is the hybrid terminal periodically switches into the 1X mode in order to receive overhead messages. The same function is performed both by the applicant and the conflicting claim except that the applicant chooses the word *update* in place of *receive*. Further, the applicant disclose that while periodically switching to update an overhead message, transmitting a signal notifying 1xEV-DO system of switching from 1xEV-DO to 1X. However, Kolev et al. (US 6125283) discloses generating a switch notification (See Kolev's figure 5, col.8 lines 5-21 where a switch notification/confirmation message is generated before a terminal is switched to another mode). Therefore, it would have been obvious to one skilled in the art to combine the invention of the application 10541251 with the invention of Kolev thereby providing a multimode system that generates a notification/confirmation message and switch to another system when it switches from one to another system.

Claims 9 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented except that the instant claims explicitly *notifying*

1xEV-DO system of switching from 1xEV-DO mode to 1X mode. Further, the applicant disclose that while periodically switching to update an overhead message, transmitting a signal notifying 1xEV-DO system of switching from 1xEV-DO to 1X. However, Kolev et al. (US 6125283) discloses generating a switch notification (See Kolev's figure 5, col.8 lines 5-21 where a switch notification/confirmation message is generated before a terminal is switched to another mode). Therefore, it would have been obvious to one skilled in the art to combine the invention of the application 10541251 with the invention of Kolev thereby providing a multimode system that generates a notification/confirmation message and switch to another system when it switches from one to another system.

Claims 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 2, 13,14, and 22 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented. The minor difference is between the word *switched* and *set* used by the applicant and the conflicting claim 5, respectively. The applicant mentions that “...*the hybrid access terminal is switched to the 1X mode in an idle state...*” and the conflicting claim 5 mentions “...*the hybrid access terminal is set as the 1X mode in an idle state...*” The use of the words *switched* and *set* in the context of the claims do not change the fact that the same function takes place.

Claims 3 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3, and 23 of U.S. Application No. 10541251.

The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4, 16, and 24 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 5 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6, 20, and 25 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 7 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 7, and 17 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 10 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9, 10, 18, and 19 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Claims 11 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of U.S. Application No. 10541251. The instant claims are broader in scope than the conflicting claims and thus encompass the subject matter previously patented.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAYED T. ZEWARDI whose telephone number is (571)272-6851. The examiner can normally be reached on 8:30-4:30.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester G. Kincaid can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sayed T Zewari/

Examiner, Art Unit 2617

August 28, 2008

/Lester Kincaid/

Supervisory Patent Examiner, Art Unit 2617